

REMARKS

Claims 1-4, 6-12 and 14-16 are pending in the present application. Claims 1, 6 and 9 have been amended. Based on the following remarks, Applicants respectfully request allowance of the pending claims.

Double Patenting Rejection of Claims 1-4, 6-7, 9-12 and 14-15

The Examiner has rejected Claims 1-4, 6-7, 9-12 and 14-15 under the judicially created doctrine of obviousness-type double patenting, over U.S. Patent No. 5,811,088. Currently pending Claims 1 and 9 do not recite "antisense oligonucleotides." Therefore, Applicants respectfully submit that there is no double patenting issue, and respectfully request the withdrawal of this rejection.

The Examiner has rejected Claims 1-4, 6-7, 9-12 and 14-15 under the judicially created doctrine of obviousness-type double patenting, over U.S. Patent No. 5,674,911. Currently pending Claims 1 and 9 do not recite "antisense oligonucleotides." Therefore, Applicants respectfully submit that there is no double patenting issue, and respectfully request the withdrawal of this rejection.

Rejection of Claims 1-4, 6-12 and 14-16 under 35 U.S.C. § 112, second paragraph

The Examiner rejected Claims 1-4, 6-12 and 14-16 under 35 U.S.C. §112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner rejected the use of "human" and "animal" in Claims 1-4, 6-12 and 14-16. Applicants have amended Claims 1 and 9 to recite "animal." Therefore, Applicants respectfully request the withdrawal of this rejection.

The Examiner also found that the Claims 1, 6-9 and 14-16 were indefinite because the portion of these claims pertaining to the range of polyoxyethylene was grammatically incorrect. Applicants have amended Claims 1 and 9 to clarify the weight of the polyoxyethylene as a percentage of the total weight of the copolymer. Therefore, Applicants respectfully request the withdrawal of this rejection.

Rejection of Claims 2 and 3 under 35 U.S.C. § 102(e)

The Examiner rejected Claims 2 and 3 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 5,567,859 to Emanuele et al. (hereinafter '859). The Examiner found Applicants' prior arguments that '859 is not prior art unpersuasive, stating that there was no literal support in the priority application (Application No. 08/138,271) of the present application, for a combination of a POP ranging in molecular weight from 3250-15000 and a POE portion greater than 20%. Thus, the Examiner concluded that the priority date for Claims 2 and 3 could be no earlier than September 30, 1996, the filing date of Application No. 08/725,842, the first continuation of Application No. 08/138,271. Applicants respectfully traverse this rejection for the following reasons.

Section 102(e) provides that "A person should be entitled to an invention unless the invention was described in a patent granted on an application for patent by another ... before the invention thereof by the applicant for patent." Applicants respectfully submit that '859 incorporates by reference Application No. 08/138,271, the priority document for the currently pending application (see col. 1, lines 38-39). Therefore, the '859 reference cannot be "before the invention of" the current application. Applicants respectfully submit that reference '859 does not anticipate Claims 2 and 3 of the present invention, and respectfully request the withdrawal of this rejection.

Rejection of Claims 2 and 3 under 35 U.S.C. § 102(g)

The Examiner rejected Claims 2 and 3 under 35 U.S.C. § 102(g), as being anticipated by U.S. Patent 5,567,859 to Emanuele et al. (hereinafter '859). The Examiner found that these claims were rejected under 35 U.S.C. § 102(g) since the inventorship of '859 is not identical to the inventorship of the present invention, rendering it unclear who invented the present invention.

Section 102(g) provides that "A person should be entitled to an invention unless before the applicant's invention thereof the invention was made in this country by another" Applicants respectfully submit that '859 incorporates by reference Application No. 08/138,271, the priority document for the currently pending application. Therefore, the '859 reference cannot be "before the invention of" the current application. Applicants respectfully submit that

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RESPONSE TO FIRST OFFICE ACTION IN RCE

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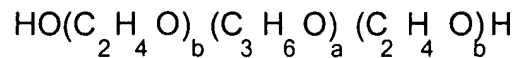
reference '859 does not anticipate Claims 2 and 3 of the present invention, and respectfully request the withdrawal of this rejection.

Applicants' representative requests a personal interview to discuss this rejection in particular.

Marked up Version of Re-written Claims

Pursuant to 37 CFR §1.121(c)(1)(ii), another version of the rewritten claims marked up to show all the changes relative to the previous version of the claims is now set forth with deleted text shown in [brackets] and added text shown in underlining:

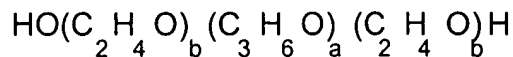
1. (Thrice Amended) A composition for treating [a human or] an animal comprising, one or more genes, oligonucleotides, [antisense oligonucleotides,] triplex DNA compounds, or ribozymes admixed with a nonionic block copolymer, wherein the block copolymer has the following formula:



wherein the molecular weight represented by the polyoxypropylene portion of the copolymer is between approximately 750 and 15,000 and the molecular weight represented by the polyoxyethylene portion of the copolymer [constitutes between] is [approximately 1% and] less than 50% of the total weight of the copolymer.

6. (Twice Amended) The composition of Claim 1 further comprising approximately 0.1% to approximately 5% by weight of a surfactant and approximately 0.5% to approximately 5% by volume of [an] a low molecular weight alcohol.

9. (Thrice Amended) A method of delivering a compound for altering gene activity to [a human or] an animal comprising, administering to [a human or] an animal a composition comprising one or more genes, oligonucleotides, [antisense oligonucleotides,] triplex DNA compounds, or ribozymes admixed with a nonionic block copolymer, wherein the block copolymer has the following formula:



wherein the molecular weight represented by the polyoxypropylene portion of the copolymer is between approximately 750 and 15,000 and the molecular weight represented by the polyoxyethylene portion of the copolymer [constitutes between] is [approximately 1% and] less than 50% of the total weight of the copolymer.

CONCLUSION

Applicants respectfully submit that this is a complete response to the Office Action dated May 3, 2002, and that Claims 1-4, 6-12, and 14-16 are patentable. Early and favorable consideration is earnestly solicited. If the Examiner believes there are other issues that can be resolved by telephone interview, or that there are any informalities remaining in the application which may be corrected by Examiner's Amendment, a telephone call to the undersigned attorney at (404) 815-6500 is respectfully solicited.

No additional fees are believed due; however, the Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, to Deposit Account No. 11-0855.

Respectfully submitted,

KILPATRICK STOCKTON, LLP

A handwritten signature in black ink, appearing to read 'Mary A. Merchant', is written over the printed name.

By: Mary Anthony Merchant, Ph.D.

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